

No. _____

05-648 NOV 9 2005

In The
Supreme Court of the United States

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FREEDMAN SEATING COMPANY,

Petitioner,

vs.

AMERICAN SEATING COMPANY,

Respondent.

**On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit**

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The doctrine of equivalents prevents a copyist from avoiding patent infringement by making unimportant and insubstantial changes to a patented invention. This Court unanimously affirmed this well-established doctrine in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), and reaffirmed its vitality in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722 (2002). In conducting an inquiry under the doctrine of equivalents, the determination of equivalence should be applied as an objective inquiry on an element-by-element basis, taking into account “whether a substitute element matches the function, way and result of the claimed element.” *Warner-Jenkinson*, 520 U.S. at 40.

The United States Court of Appeals for the Federal Circuit has held on numerous occasions, including the case at bar, that where an element of an accused device was known to an inventor to be “foreseeably” interchangeable with an element of a patent claim, this factor weighs **against** a finding of equivalence as to that element. However, this Court has previously held, as affirmed most recently in *Warner-Jenkinson*, that the “known interchangeability” of an element of an accused device and an element of a patent claim, is a factor that expressly weighs **in favor of** a finding of equivalence – not against it.

QUESTIONS PRESENTED - Continued

The questions presented, therefore, are:

1) Whether a court can find non-equivalence between an element of an accused device and an element of a patent claim, as a matter of law, so as to deprive the patentee of its right to a jury trial, where there is no factual dispute that the claimed and accused elements are interchangeable; and

2) Whether a court can find non-equivalence between an element of an accused device and an element of a patent claim, as a matter of law, where there is no factual dispute that the accused element performs the same function in the same way to achieve the same result as the claimed element.

PARTIES TO THE PROCEEDING

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Petition for Writ of Certiorari.

RULE 29.6 STATEMENT

Petitioner Freedman Seating Company has no parent corporation and no publicly held company owns 10% or more of Petitioner's stock.

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OPINIONS BELOW

The opinion of the U.S. Court of Appeals for the Federal Circuit is reported at 420 F.3d 1350, and is reprinted in the Appendix to the Petition ("App.") at App. 1-29. The district court's order granting summary judgment to Freedman on the issues of infringement and validity, which is not reported, is reprinted at App. 30-55. The district court's order granting in part and denying in part Respondents' motion for reconsideration, which is not reported, is reprinted at App. 56-63. The district court's order granting summary judgment to Freedman on the issue of inequitable conduct, which is not reported, is reprinted at App. 64-71.

JURISDICTION

The Court of Appeals entered its judgment on August 11, 2005. This Court has jurisdiction under 28 U.S.C. §1254(1).

STATUTE INVOLVED

35 U.S.C. §271(a) provides:

"Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent."

STATEMENT OF THE CASE

This case presents two questions which involve the "whittling away" of the "doctrine of equivalents" by the Court of Appeals for the Federal Circuit, in a manner which adversely affects the expectations of patent owners based upon this Court's precedent. Under this well-established doctrine, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997). This doctrine has been consistently applied by this Court, in numerous cases, since the doctrine was first embraced in 1853. See *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608-09 (1950) (listing cases). The application of the doctrine of equivalents is a frequently recurring issue in patent law and practice.

A. The '389 Patent

Petitioner Freedman Seating Company ("Freedman") owns U.S. Patent No. 5,492,389 ("the '389 patent") (App. 3). The '389 patent covers a stowable seat for transit vehicles (such as buses, trains, etc.) which is able to move between a horizontal (deployed) position and a vertical (stowed) position, to provide space for positioning a wheelchair within the vehicle (App. 3-5). The stowable seat of the invention comprises a seatback and a seatbase which are attached to a frame (App. II-5, '389 patent, col. 1, lines

40-45).¹ Moving the seat from its horizontal to its vertical position generally involves folding the seatback flat against the seatbase, unlocking the seatbase, and raising the seatbase to its vertical position where it is locked in place (App. 5; '389 patent, col. 1, lines 19-24).

The novelty of the invention lies in the fact that the stowable seat does not use an aisle leg to support the seat when in the horizontal position, but rather is based on a cantilever design, in which the free (or aisle) end of the seatbase is supported by a diagonal truss, or "support member" (App. 5; App. II-5, '389 patent, col. 1, lines 25-35; 52-58). The diagonal truss has a fixed end attached to the seat's frame at a pivot point, and a movable end attached to the free end of the seatbase (App. 5; App. II-5, '389 patent, col. 1, lines 48-52). Notably, the attachment point for the movable end of the diagonal truss **shifts** from a position under the middle of the seatbase when the seat is stowed, to a position under the aisle end of the seatbase when the seat is deployed, to provide passenger support for the aisle end of the seatbase. In so doing, the diagonal truss provides the seatbase with a range of motion extending from its horizontally deployed position to its vertically stowed position (App. 5; App. II-5, '389 patent, col. 1, lines 48-52).

In the preferred embodiment of the invention shown in the '389 patent, the movable end of the diagonal truss shifts by sliding on a runner track which is mounted to the

¹ In view of the fact that the Court of Appeals' discussion of the '389 patent and the accused devices is at times incomplete and/or factually inaccurate, Petitioner has submitted herewith a copy of the '389 patent itself, pursuant to Supreme Court Rule 32.3 (App. II-1-App. II-8), to enable this Court to fully appreciate the technical details of the invention.

underside of the seatbase, to enable the seatbase to be rotatably transitioned between its horizontal and vertical positions (App. 5; App. II-2; App. II-5, '389 patent, col. 1, lines 19-24).² Notably, the movable end of the diagonal truss is provided with both **translational** (i.e., side-to-side) **and rotational** motion relative to the seatbase, as the seatbase is raised from its horizontal to its vertical position (App. II-6, '389 patent, col. 3, lines 41-56). However, the Court of Appeals failed to address the fact that the '389 patent expressly teaches that the movable end of the diagonal truss moves both translationally **and** rotationally, relative to the seatbase (App. 5). It is undisputed that the mechanism formed by the seatbase, the diagonal truss and the frame forms what is known to one of skill in the art of mechanical engineering as a "slider crank," which is a particular type of a general class of mechanisms known in the art as "four bar mechanisms" (App. 5).³

B. The Accused EZ Fold Seat

Respondents American Seating Company and Hi-Tech Seating Products, Inc. (collectively "Respondents") compete with Freedman in the manufacture and sale of

² While the Court of Appeals refers to the movement of the seatbase as "translational movement of the seatbase between the horizontal and vertical positions" (App. 5), this is an inaccurate description. In actuality, the seatbase *cannot* move translationally, inasmuch as it is mounted to the frame at its fixed end. Rather, the seatbase *rotates* about its fixed end, between its horizontal (deployed) position and its vertical (stowed) position.

³ Again, the Court of Appeals' description here is inaccurate, as it refers to the "folding mechanism created by the slidably mounted movable end" as a "slider crank," when in actuality it is the entire seatbase-diagonal truss-frame assembly that forms the "slider crank" type of "four bar mechanism."

seating products for the transportation industry (App. 7). Respondents manufacture and sell a competing stowable seat under the name "Horizon EZ Fold" ("EZ Fold"), which the Federal Circuit expressly acknowledged is, in nearly all respects, identical to Freedman's patented seat (App. 7).

The sole difference between the EZ Fold and Freedman's patented seat is the fact that the EZ Fold seat includes an insubstantial change in the way the movable end of the diagonal truss is mounted to the seatbase. Rather than being mounted to the seatbase by way of a runner track, as is the case with Freedman's patented seat, the movable end of the EZ Fold support member is mounted to the seatbase by way of an additional truss, referred to by the Court of Appeals as a "fourth link" (App. 7). The movable end of the EZ Fold diagonal truss is attached to one end of the "fourth link," while the other end of the "fourth link" is fixed to the bottom of the seatbase at a single location (App. 7-8). Thus, the movable end of the EZ Fold, like the movable end of Freedman's patented seat, is provided with both **translational and rotational** motion relative to the seatbase, as the seatbase is raised or lowered between its horizontal and vertical positions.⁴ It is likewise undisputed that the

⁴ Again, the Court of Appeals' description of the motion of the EZ Fold's movable end is inaccurate. While the Court of Appeals states that "the only range of motion [of the EZ Fold movable end] consists of rotation throughout its revolute joints" (App. 7), that statement is simply incorrect. In actuality, the movable end of the EZ Fold diagonal support moves both translationally and rotationally with respect to the EZ Fold seatbase. This is best appreciated by reference to the diagrams in the record below showing the EZ Fold seat as it moves from its horizontal position to its vertical position, several of which are shown at App. 8, and the entirety of which (found at Fed. Cir. Appendix A2994-3013) are submitted herewith, pursuant to Supreme Court Rule 32.3,

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